



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,259	12/29/2000	Victor Shao	50277-1525	4588

42425 7590 02/23/2007
HICKMAN PALERMO TRUONG & BECKER/ORACLE
2055 GATEWAY PLACE
SUITE 550
SAN JOSE, CA 95110-1089

EXAMINER

ELALLAM, AHMED

ART UNIT	PAPER NUMBER
----------	--------------

2616

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/751,259

Applicant(s)

SHAO ET AL.

Examiner

AHMED ELALLAM

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8, 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

This communication is responsive to Amendment filed on 11/24/2006. The Amendment has been entered.

Claims 1, 3-8, 10-14 are pending and rejected.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1, 3-8, 10-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed invention in claims 8, 10-14 is directed to non-statutory subject matter, because the steps claimed are performed within a computer readable media. A computer readable media by itself for performing the plurality of steps lacks patentable utility.

Regarding claims 1, 3-7, these claims have the same limitations of respective claims 8, 10-14, and since these limitations are identical to the non-statutory claimed subject matter of claims 8, 10-14 that are subjected to the lack of utility, these claims are also subject to the lack of utility by the same analogy.

In addition, Applicants defined as an example of computer readable media as a transmission media, (specification page 39, line, 11), carrier wave (specification, page 39, and line 18. Therefore, interpreting the claimed computer media of claims 8, 10-14

Art Unit: 2616

in light of the specification to mean transmission media, and/or carrier wave renders these claims of being non-statutory, because no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3-8, 10-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1 and 8, the specification as original filed doesn't disclose the limitations " wherein the step of transmitting said survey results includes transmitting said survey results from said server to a plurality of *members of the online community that are not associated with said particular party that defined said survey*; receiving, through user interface controls on a second mobile device, user input requests said survey results, *wherein the user input does not initiate the creation of said survey*"

Art Unit: 2616

Regarding claims 3-7, 10-14, these claims depend from respective claims 1 and 8 thus they are subject to the same rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 4, 8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brookler et al, US 2002/0007303 in view of Coleman, US 2004/0024656. Hereinafter referred to as Brookler and Coleman respectively.

Regarding claims 1, 3, 8, 10, with reference to figure 1, Brookler discloses a method/a computer-readable medium carrying instruction for sharing surveys with a plurality of a survey respondents 16 (claimed on-line community) comprising:

A survey respondent 16 responds to a survey questions which is collected by a survey result (and analyses) database 22 (claimed gateway), the mobile device using a WAP (Wireless access Protocol) (claimed first protocol), the wireless having an interface (claimed user interface controls), see paragraph [0031], (claimed establishing a first connection between a mobile device and a gateway using a first protocol; wherein the mobile device support a first protocol but not a second protocol); Examiner interpreted the use of the wireless devise having the wireless interface for transmitting the survey to the survey result database 22 as being the claimed establishing a first

connection, because a connection need to be established for the receiving of the survey questions; and survey response using the wireless device as being the claimed receiving user input that indicates the opinion through user interface controls on the mobile device; and Brookler's ability of collecting the survey response of the wireless unit user by the survey result database 22, as being the claimed transmitting from the mobile device to the gateway, opinion data indicating the opinion, in a message that is not addressed to any specific member of the community, using the first protocol).

Transmitting the user surveys to the publishing engine 14 (claimed server) that publishes survey results after being analyzed, using a markup language, see figure 6, step 96, paragraph [0065] and paragraph [0073]; (claimed storing opinion data as part of survey results at said server, the survey results reflects opinion data from a plurality of members of the online community).

Brookler, further discloses, with reference to figure 6, transmitting reports (claimed survey results) using different protocol such as HTML, from the publishing engine 14 to surveyors in response to received survey request (step 1 figure 1) received by the publishing engine in marked up protocol format (figure 6, unit 96).

Examiner interpreted the market-up language used between the database 22 and the publishing engine 14, as being the claimed usage of second protocol.

Brookler doesn't specify receiving, through user controls on a second mobile device, user input that request the survey results, the second mobile device being a member of the community and not the party that define the survey; transmitting, a request for the survey results, using the WAP protocol from the second mobile to the

Art Unit: 2616

gateway, transmitting a request for the survey using the HTTP protocol from the gateway to the server; in response to the request received at the server using the HTTP protocol, transmitting the survey results, using the HTTP protocol to the gateway, and sending the survey results, using the WAP protocol, from the gateway to the second mobile device.

However, Coleman discloses, a survey requester coupled to the Internet through a wireless link, the survey requester being a non participating in the survey and not the party that define or initiate the survey. See paragraphs [0028], [0051]-[0052] and [0112].

Therefore, it would have being obvious to an ordinary person of skill in the art, at the time the invention was made to provide the mobile users of Brookler to request surveys without being the party that define survey as taught by Coleman. The advantage would be the ability to provide an incentive to keep the on-line community of Brookler in providing responses in a curious manner in future surveys by giving access to survey results at any time regardless whether a member of the on-line community participated in a specific survey or not.

(Note: the system of Brookler provides all the necessary hardware as indicated above (gateway server interfaces, etc.) for providing the second mobile with the survey results, the second mobile being a survey requester and not a party that define the survey, as indicated by Coleman).

Regarding claims 4 and 11, Brookler discloses using a wireless connection between the mobile device 16 and the survey result database 22 (claimed transmitting opinion data from the mobile device to the gateway includes transmitting the opinion

Art Unit: 2616

data over a wireless connection). In addition, with reference to figure 1, Brookler shows that the database 22 (claimed gateway) and publishing engine 14 (claimed server) are interconnected through the Internet, see also paragraph [0003]. (Claimed transmitting opinion data from the gateway to the server includes transmitting opinion data over a network to which both the gateway and the server are connected).

4. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brookler in view of Coleman as applied to respective claims 1 and 8 above, and further in view of Parker et al, US 2002/0052774.

Regarding claims 5 and 12, Brookler in view of Coleman discloses all the limitations of base claim 1, except they don't disclose receiving from publishing engine previous survey data (claimed opinion) prior to imputing the user response, wherein the user input is entered as a response to previous survey responses (claimed previous opinion), and the server storing an association between previous survey response and the survey response (claimed prior to receiving user input that indicates the opinion, the mobile device receiving from the server, previous opinion data that indicates an opinion previously stored on the server, wherein the user input is entered as a response to the previous opinion data and the server storing an association between the previous opinion data and the opinion data).

However, Parker discloses with reference to figure 2, a follow-up survey to a previous survey, in which a server (unit 12, figure1) stores previous survey result and follow-up survey result, wherein a client's respondent to the follow-up survey is based

Art Unit: 2616

on the previous survey stored at the server. See abstract, paragraphs [0004], [0005] and [0022].

Therefore, it would have being obvious to an ordinary person of skill in the art, at the time the invention was made to provide the surveying method of Brookler in view of Coleman with the follow-up surveying of Parker, so that correlation between surveys can be provided in the system of Brookler in view of Coleman, A person of skill in the art would be motivated by having the surveys of Brookler in view of Coleman be more specific (Parker paragraph [0005]). The advantage would be the ability of Brookler in view of Coleman's system to provide different levels of surveys, (Parker paragraph [0025]).

5. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brookler in view of Coleman as applied to respective claims 1 and 8 above, and further in view of Plantec et al, US (6,826,540).

Brookler in view of Coleman discloses all the limitations of respective base claims 1 and 8, except they don't explicitly disclose storing responses (claimed opinion data) and transmitting the opinion data with previously stored survey responses entered by the user, (claimed the opinion data is stored within the mobile device; and the stored opinion data is transmitted from the mobile device to the gateway in a batch with other opinion data previously entered by the user of the mobile device).

However, Plantec discloses a survey input client that transmits responses of a survey as an answer file (claimed batch) after the survey being stored in the client

Art Unit: 2616

computer, wherein the survey responses are previously entered by a survey participant.

See column 9, lines 38-45 and column 35, lines 47-56.

Therefore, it would have being obvious to an ordinary person of skill in the art, at the time the invention was made to have the survey participant of Brookler in view of Coleman to stores the survey responses in their mobile devices so that the final surveys can be complete. The advantage would be more reliable and accurate survey results (Plantec column 1, lines 34-44) emanating from proper time given to participants to come up with the most reasonable opinion, given various circumstances between events that may change participants opinion.

6. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brookler in view of Coleman as applied to claims 1 and 8 above, and further in view of Nardone et al, US (6,535,885).

Regarding claims 7 and 14, Brookler in view of Coleman discloses all the limitations of base claim 1, except they don't explicitly disclose storing opinion data within the mobile while the mobile doesn't have a connection to the gateway, and transmitting the stored opinion data after a connection is established between the mobile and the gateway.

However, Nardone discloses collection of data being stored in a PDA prior to establishing a wireless connection, see column 1, lines 32-39, and column 3, lines 19-25. It would have being obvious to an person of ordinary skill in the art, at the time the invention was made to make the opinions stored at the mobile device of Brookler in

Art Unit: 2616

view of Coleman prior to establishing a connection as taught by Nardone so to save the power of the mobile while the opinion is not finished yet. It would be also advantageous to store survey data by Brookler in view of Coleman' users in times where the mobile is incapable of establishing a connection with the gateway for enabling the users to participate in surveys without being continuously connected to the network.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 3-8, 10-14 have been considered but are moot in view of the new ground(s) of rejection.

8. Examiner indicated the non-statutory claimed subject matter of claims 8, 10-14 during the interview conducted on 05 January 2006 with attorney Daniel D. Ledesma to further the prosecution. However, after further search and consideration, the reference to Colmeman is found to be of interest to the claimed subject matter, and other remaining issues (112 rejections) as shown above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: See Form PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED ELALLAM whose telephone number is (571) 272-3097. The examiner can normally be reached on 9-5:30.

Art Unit: 2616

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, To Doris can be reached on (571) 272-7629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A.E
Examiner
Art Unit 2616
2/20/07



DORIS H. TO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600